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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,120	12/21/1998	TADAMASA KITSUKAWA	80398.P160	3528

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EXAMINER

LONSBERRY, HUNTER B

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 12/10/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/218,120

Applicant(s)

KITSUKAWA ET AL.

Examiner

Hunter B. Lonsberry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 93-98 is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-69, 71-77, 80, 81, 83-89 and 92 is/are rejected.
- 7) ☒ Claim(s) 20, 21, 71-73, 78, 79, 83-85, 90 and 91 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 21 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant is advised that should claims be found allowable, claims 20, 21, 78, 79, 90, and 91 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

Claims 71-73 and 83-85 objected to because of the following informalities: Claims 71-73 depend on claim 70 which was canceled, Claims 83-85 depend on claim 82 which was canceled. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 9, 10, 15-17, 19, 24, 25, 28-31, 33, 37, 43-45, 48-52, 55, 62, 63, 65-67, 69, 71, 74, 77, 81, 83, 86, 87, and 89 rejected under 35 U.S.C. 103(a) as being

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unpatentable over U.S. Patent 5,287,181 to Holman in view of U.S. Patent 6,035,305 to Machida.

Regarding claim 1, Holman discloses in Figure 2 an electronic coupon system 1, which receives coupon information along with a program broadcast (column 6, lines 5-12), the coupon system has a coupon display mode (Figure 1, column 6, lines 5-12, 39-40), and alerts a user when a coupon is available by displaying a logo during a commercial (column 6, lines 5-12), and coupon information is displayed along with the program (column 6, lines 5-12). Holman does not disclose allowing a use to select a coupon mode from a number of display modes. Machida discloses an EPG system, which allows a user to select a number of display modes, including an EPG display mode and a coupon display mode (Figures 6, 64, 67, column 24, lines 4-58). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Holman with the multiple display modes of Machida, thereby enabling an uninterested user to not display coupon information.

Regarding claims 2, 51, Holman discloses an electronic coupon display system, which receives coupon information along with program data(column 6, lines 5-12) and stores the coupon information (column 6, lines 34-38).

Regarding claims 3, 33, 52, 67, Holman discloses the use of a smart card used by a viewer (column 6, lines 56-64), and that coupon information is stored locally for any coupon data a user is interested in (column 6, lines 24-38).

Regarding claims 5, 71, Holman discloses a stored coupon mode (column 6, lines 39-43). Holman does not disclose a non-coupon display mode. Machida discloses

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an EPG system, which allows a user to select a number of display modes, including an EPG display mode and a coupon display mode (Figures 6, 64, 67, column 24, lines 4-58). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Holman with the multiple display modes of Machida, thereby enabling an uninterested user to not display coupon information.

Regarding claims 9, 37, 55, 74, and 86 Holman discloses in Figure 2, an electronic coupon system which displays a logo 40 alerting a viewer that a coupon is available, a viewer may press a view button 9 (Figure 1) additional information regarding the coupon is displayed (column 6, lines 5-38).

Regarding claim 15, Holman discloses an electronic coupon system, which utilizes a magnetic card on which coupon information maybe stored, a user may swipe the card through a card reader at the time of purchase at a store, which decodes the coupon information (column 18, line 59-column 19, line21).

Regarding claim 16, Holman disclosers an electronic coupon system, which allows a user to download coupons into memory; the coupons can be reviewed at a time after they were originally broadcast (column 6, lines 5-64). Holman does not disclose storing all incoming coupon information. Machida discloses a STB with a hard drive in Figure 4, which receives and stores all incoming application data (SAI Data), this data may be retrieved later when an application request is issued by a user (column 6, line 24-column 8, line 23, column 24, lines 4-58). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Holman to store all

incoming application data, as taught by Machida, so that a user could review all the coupons displayed during a program and decide which one to utilize.

Regarding claims 17, 43, 63, and 87 Holman discloses an electronic coupon system which overlays coupon information over the displayed TV program (column 6, lines 5-12).

Regarding claims 19, 44, 77 and 89, Holman discloses an electronic coupon system that downloads coupon information at the same time an advertisement is displayed (column 6, lines 5-12).

Regarding claim 24, Holman discloses an electronic coupon system that generates coupons related to a product, which is advertised onscreen (column 6, lines 5-12).

Regarding claims 25, 45, and 65, Holman discloses an electronic coupon system, which alerts a user when a coupon is available by displaying an icon during scenes in an advertisement (column 6, lines 5-38).

Regarding claims 28, 48, and 62, Holman discloses an electronic coupon system in which items advertised during commercials may have an associated coupon which is downloaded into a set top box (column 6, lines 5-20), the coupon may be stored for a set amount of time before it becomes invalid (column 18, lines 30-47).

Regarding claims 29, 49, 66 Holman discloses an electronic coupon system which alerts a user when a coupon is available by displaying an icon during scenes in an advertisement, displays advertising information, and displays information during the broadcast of the advertisement (column 6, lines 5-38).

Regarding claim 30, Holman discloses in Figure 2 an electronic coupon system 1 which is coupled to display 39 and contains a processor (control circuit 117, Figure 3, column 10, lines 36-53), which receives coupon information along with a program broadcast (column 6, lines 5-12), the coupon system has a coupon display mode (Figure 1, column 6, lines 5-12, 39-40), and alerts a user when a coupon is available by displaying a logo during a commercial (column 6, lines 5-12), and coupon information is displayed along with the program (column 6, lines 5-12).). Holman does not disclose allowing a use to select a coupon mode from a number of display modes. Machida discloses an EPG system, which allows a user to select a number of display modes, including an EPG display mode and a coupon display mode (Figures 6, 64, 67, column 24, lines 4-58). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Holman with the multiple display modes of Machida, thereby enabling an uninterested user to not display coupon information.

Regarding claim 31, Holman discloses in Figures 2 and 3, an electronic coupon system with a display 39 and processor 117.

Regarding claim 50, Holman discloses in Figure 2 an electronic coupon system containing a processor (control circuit 117, Figure 3, column 10, lines 36-53), which receives coupon information along with a program broadcast (column 6, lines 5-12), the coupon system has a coupon display mode (Figure 1, column 6, lines 5-12, 39-40), and alerts a user when a coupon is available by displaying a logo during a commercial (column 6, lines 5-12), and coupon information is displayed along with the program (column 6, lines 5-12). Processor 117 inherently reads from a memory device

containing executable instructions for the operation of the device, as this is essential to the operation of the processor.). Holman does not disclose allowing a use to select a coupon mode from a number of display modes. Machida discloses an EPG system, which allows a user to select a number of display modes, including an EPG display mode and a coupon display mode (Figures 6, 64, 67, column 24, lines 4-58). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Holman with the multiple display modes of Machida, thereby enabling an uninterested user to not display coupon information.

Regarding claim 69, Holman discloses in Figure 2 an electronic coupon system 1, which receives coupon information along with a program broadcast (column 6, lines 5-12) that has been transmitted via a cable to STB 33; coupon information is displayed along with the program (column 6, lines 5-12) in a coupon display mode,), the system alerts a user when a coupon is available by displaying a logo during a commercial with the coupon information sent simultaneously (column 6, lines 5-12). Holman does not disclose allowing a use to select a coupon mode from a number of display modes. Machida discloses an EPG system, which allows a user to select a number of display modes, including an EPG display mode and a coupon display mode (Figures 6, 64, 67, column 24, lines 4-58). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Holman with the multiple display modes of Machida, thereby enabling an uninterested user to not display coupon information.

Regarding claim 81, Holman discloses an electronic coupon system in Figure 3, in which a STB 33 receives video and coupon data over a cable; the coupon data is

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displayed on screen along with the video (column 6, lines 5-38), with an alert via icon 70 indicating when a coupon is available, the coupon icon is shown during an advertisement for a product onscreen, once a coupon is selected for download, a user may enter a coupon display mode which lists downloaded coupons (column 6, lines 5-64). Holman does not disclose allowing a user to select a coupon mode from a number of display modes. Machida discloses an EPG system, which allows a user to select a number of display modes, including an EPG display mode and a coupon display mode (Figures 6, 64, 67, column 24, lines 4-58). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Holman with the multiple display modes of Machida, thereby enabling an uninterested user to not display coupon information.

Regarding claim 83, Holman discloses an electronic coupon system, which has a regular TV display mode and a stored coupon mode (column 6, lines 5-64).

Claims 4, 6, 7, 18, 22, 23, 32, 34-36, 53, 54, 64, 68, 72, 73, 75, 76, 80, 84, 85, and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,287,181 to Holman in view of U.S. Patent 6,035,305 to Machida.

Regarding claims 4, 34, and 68, Holman discloses in Figure 2, an electronic coupon system that displays a logo 40 alerting a viewer that a coupon is available. Holman does not disclose the use of a HDTV system. The examiner takes official notice that the use of HDTV is well known within the art. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of

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Holman and Machida to display and include electronic coupons on HDTV systems thereby enlarging the number of viewers available to advertisers.

Regarding claims 6, 35, 53, 72, 84, Holman discloses in Figure 2, an electronic coupon system that displays a logo 40 alerting a viewer that a coupon is available. Holman does not disclose the use of a tone to alert a viewer of a coupon. The examiner takes official notice that the use of a tone to alert a viewer is well known within the art. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to include a tone in order to alert a viewer who may be away from the television that a coupon is available.

Regarding claims 7, 36, 54, 73, 75, 85, Holman discloses in Figure 2, an electronic coupon system which displays a logo 40 alerting a viewer that a coupon is available and is superimposed over the displayed video (column 6, lines 5-7).

Regarding claim 8, Holman discloses in Figure 2, an electronic coupon system that displays a logo 40 alerting a viewer that a coupon is available for a selected product (column 6, lines 5-7, 23-27).

Regarding claims 18, 76 and 88, Holman discloses an electronic coupon system which overlays coupon information over the displayed TV program (column 6, lines 5-12). Holman does not disclose a system in which a user may select what part of the display the coupon information should be overlaid upon. The examiner takes official notice that user customizable displays are well known within the art. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to allow a user to choose where to display

coupon information so that onscreen displays such as sports scores, timers or stock quotes could still be visible while coupon information was displayed onscreen.

Regarding claims 22, 32, 64, 80, and 92, Holman discloses an electronic coupon system that provides coupons related to a product onscreen during an advertisement (column 6, lines 5-38). Holman does not disclose providing coupon information during a variety of other programs. The examiner takes official notice that the use of a set top box for displaying live television programs, prerecorded television programs, live television commercials, prerecorded television commercials, movies and pay per view programming is well known in the art. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to display coupon information during a variety of television events to provide a subscriber coupon information for products to provide additional opportunities for a subscriber to view coupon information as the subscriber may have been away from the television during a commercial break.

Regarding claim 23, Holman discloses an electronic coupon system that provides coupons related to a product onscreen such as Coke® (column 6, lines 5-38). Holman does not disclose generating coupons for services. The examiner takes official notice that coupons related to services are well known within the art. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to include coupons for services in order to increase the pool of advertisers.

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Claims 10-14, 26, 38, 39, 41, 42, 46, and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,287,181 to Holman in view of U.S. Patent 6,035,305 to Machida and in further view of U.S. Patent 5,559,549 to Hendricks.

Regarding claims 10, 38, and 56, Holman discloses an electronic coupon system, which stores coupon data on a magnetic card (column 6, lines 56-64). Holman does not disclose a system, which stores TV program data on a removable medium. Hendricks discloses a TV program delivery system which stores a program title, description, date of airing, time of airing and broadcast channel on a set top box (column 13, lines 36-50). Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to store TV program descriptive information on the magnetic card to allow retailers to track program viewing habits of their customers allowing them to better direct their advertising resources.

Regarding claims 11 and 39, Holman discloses an electronic coupon system, which downloads coupons related to advertising (column 6, lines 5-38).

Regarding claims 12, 57, Holman discloses an electronic coupon system in which coupon information is stored on a magnetic card and is read and then redeemed in a retail store (column 18, line 59-column 19, line 21). The combined system of Holman and Machida does not disclose a system, which downloads program information to a smart card and later transfers it to a program information collection center. Hendricks discloses a CATV network, which stores program information in a set top box and later reports viewing information to the headend (column 13, lines 36-50,

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column 14, lines 43-60). Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to store TV program descriptive information on the magnetic card to allow retailers to track program viewing habits of their customers allowing them to better direct their advertising resources.

Regarding claim 13, 41, 58, Holman discloses an electronic coupon system in which a user must decide which coupons they are interested in before downloading them to a magnetic card (column 6, lines 5-64).

Regarding claim 14, 42, 59, Holman discloses an electronic coupon system in which a user must decide which coupons they are interested in before downloading them to a magnetic card (column 6, lines 5-64); once the coupons are downloaded to a card, then a user may utilize them in a store (column 14, lines 43-60).

Regarding claims 26, 46, 60, Holman discloses an electronic coupon system in which a user utilizes a display list button 13, which brings up a coupon menu, which a user may navigate with up arrow 15 and down arrow button 17. Holman does not disclose the use of a program guide for navigating the coupons. Hendricks discloses the use of a program guide menu for navigating TV programming. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to include the program guide as taught by Hendricks so that a user would have an easier time navigating available programming choices thus spending less time channel surfing.

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Claim 27, 47, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,287,181 to Holman in view of U.S. Patent 6,035,305 to Machida and in further view of U.S. Patent 6,002,394 to Bruck.

Regarding claims 27, 47, and 61, Holman discloses a system for downloading coupons to a smart card from a CATV network. Holman does not disclose providing electronic links to a manufacture's or dealer's webpage or electronic catalog. Bruck discloses an Internet accessible set top box (column 4, lines 31-42), which uses the Internet to retrieve web pages for a subscriber. The examiner takes official notice that the use of web pages as an electronic product catalog is well known in the art. Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Holman and Machida to include Internet accessibility in order to provide user additional information on products which they had received a coupon for.

Allowable Subject Matter

Claims 93-98 allowed.

Claims 20, 21, 78, 79, 90, and 91 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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U.S. Patent 5,500,681 to Jones: Apparatus and Method for Generating Product Coupons in Response to Televised Offers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 703-305-3234. The examiner can normally be reached on Monday-Friday normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5359 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

HBL
November 21, 2002


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